

REMARKS

Upon entry of the instant amendment, claims 1-2 and 5-9 will remain pending in the above-identified application and stand ready for further action on the merits.

In this Amendment, claim 1 has been amended to recite limitations previously recited in claim 4 (*and claim 4 has been canceled to prevent a redundancy with amended claims*). Claim 3 has additionally been canceled.

Accordingly, the present amendments to the claims do not introduce new matter into the application as originally filed. As such entry of the instant amendment and favorable action on the merits is earnestly solicited at present.

Information Disclosure Statement

The Examiner states that JP 11-217356A listed on the IDS filed February 24, 2006 has not been received.

The JP 11-217356A reference was originally cited in the International Search Report for PCT/JP2004/012601, of which the current application is the 35 USC § 371 national phase application. Accordingly, the JP 11-217356A reference should have been forwarded to the PCT branch of the USPTO from the International Bureau of WIPO and/or obtained by the PCT branch of the USPTO from the International Bureau of WIPO upon commencement of prosecution of the instant 35 USC § 371 application.

In any event, in order to expedite further prosecution of the instant application to allowance, enclosed herewith is a clean copy of JP 11-217356A with an English translation of the Abstract and a clean copy of the original copy of the earlier filed SB08.

The Examiner is respectfully requested to initial the enclosed SB08 form to clearly indicate that the JP 11-217356A reference has been fully considered.

Priority Documents

The USPTO indicates that applicant has not filed a certified copy of foreign priority document 2003-384566.

Enclosed is a copy of PCT/IB/304 received in the matter of PCT/JP2004/012601 (*from which the instant application is a 35 USC § 371 national phase application*) clearly indicating that on October 15, 2004 a copy of each of priority documents JP 2003-209042 and JP 2003-384566 were received by the International Bureau under PCT Rule 17.1(a) or (b).

Accordingly, a copy of the same priority documents should have been forwarded to the PCT branch of the USPTO from the International Bureau of WIPO and/or obtained by the PCT branch of the USPTO from the International Bureau of WIPO upon commencement of prosecution of the instant 35 USC § 371 application.

Accordingly, the USPTO is respectfully requested to obtain a copy of the JP 2003-384566 priority document from the International Bureau of WIPO, thereby fulfilling the requirements of 35 USC § 119(b).

Claim Objection

Claim 4 has been objected to for depending on a rejected base claim. Reconsideration and withdrawal of this claim objection is respectfully requested based on the amendment of claim 1 herein to recite the limitations of prior claim 4 (which has been canceled to avoid a redundancy

with amended claim 1). Accordingly, reconsideration and withdrawal of the outstanding objection is required at present.

Claim Rejection under 35 USC § 103(a)

Claims 1-3 and 5-9 are rejected under 35 USC § 103(a) as being unpatentable over WO 01/92223 in view of WO 03/024958 and Berkaoui et al. (TETRAHEDRON, 54, p. 9057 (1998)). Reconsideration and withdraw of the instant rejection is respectfully requested based on the following considerations.

Legal Standard for Determining Prima Facie Obviousness

MPEP § 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

Graham v. John Deere, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP § 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Exemplary rationales that may support a conclusion of obviousness include:

- (a) *combining prior art elements according to known methods to yield predictable results;*
- (b) *simple substitution of one known element for another to obtain predictable results;*
- (c) *use of known technique to improve similar devices (methods, or products) in the same way;*
- (d) *applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;*
- (e) *"obvious to try" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success*
- (f) *known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;*
- (g) *some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.*

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. See MPEP § 2143.03.

Distinctions Over the Cited Art

Claim 1 now positively recites the limitations of prior claim 4 (*which claim was not rejected over the above references*). It is also noted that each of claims 2 and 5-9 depend from amended claim 1 and therefore also recite and include the limitations of amended claim 1, so that they are also patentable over the cited art being applied in the instant rejection.

Additionally, it is submitted that the cited art fails to provide any reason or rationale that would allow one of ordinary skill in the art to arrive at the instant invention as claimed.

Conclusion

In view of the amendments and remarks presented herein, the USPTO is respectfully requested to issue a Notice of Allowance in the matter of the instant application clearly indicating that each of instantly pending claims 1-2 and 5-9 are allowed and patentable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey, Reg. No. 32,881 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: December 16, 2008

Respectfully submitted,

By 

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Attachment(s): JP 11-217356A with a clean SB08, and
PCT/IB/304 for PCT/JP2004/012601